



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/763,106	02/16/2001	Martin Sugar	BEIERSDORF 7	3482

7590 09/23/2002

Norris McLaughlin & Marcus
220 East 42nd Street
30th Floor
New York, NY 10017

EXAMINER

BERMAN, ALYSIA

ART UNIT	PAPER NUMBER
----------	--------------

1617

DATE MAILED: 09/23/2002 11

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/763,106

Applicant(s)

SCHMUCKER ET AL.

Examiner

Alysia Berman

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 June 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 1617

DETAILED ACTION

Receipt is acknowledged of the change of address filed April 4, 2002 and the amendment and declaration filed June 24, 2002. Claims 1-6 have been cancelled.

Claims 7-18 have been added and are pending.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 7-12 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for reducing the attachment of lauryl ether sulfate to human skin during a washing process, does not reasonably provide enablement for preventing the attachment of lauryl ether sulfate to human skin during a washing process. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims. Applicant has not provided any data showing prevention of the attachment of lauryl ether sulfate to human skin. The skin cleanser/detergent art is unpredictable. It would take undue experimentation for one skilled in the art to determine prevention of attachment of lauryl ether sulfate to human skin. One skilled in the art is not enabled to use the invention as claimed.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

Art Unit: 1617

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 12 and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 12 and 18 are indefinite because they claim a concentration of lauryl ether sulfate in the compositions but the compositions of the independent claims do not contain lauryl ether sulfate. Does Applicant intend for the composition of the independent claims to contain lauryl ether sulfate?

Claim Rejections - 35 USC § 102/103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

Art Unit: 1617

were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 7-11 and 13-17 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over EP 0 648 833 A1 (833).

EP '833 discloses washing the forearm with compositions containing 25% potassium lauroyl glycinate, an N-acylamino acid salt. See Table 5 and lines 19-21 at page 12. Any properties exhibited by the composition do not render the claims patentable over the prior art. A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. *In re Spada*, 911 F.2d 705, 709, 15 USPQ 1655, 1658 (Fed. Cir. 1990). See MPEP §2112.01. The burden is shifted to Applicant to show that the prior art product does not inherently possess the same properties as instantly claimed product. The prior art product contains the instantly claimed ingredients and is used in the instantly claimed manner. Therefore, it would inherently prevent or reduce attachment of lauryl ether sulfate to human skin during the washing process.

Although it is the Examiner's primary opinion that EP '833 anticipates the instant claims, in the alternative, it is obvious over EP '833. EP '833 does not explicitly teach application of the compositions to skin, *per se*. However, throughout it discloses that the

Art Unit: 1617

compositions are detergents and cleansers that leave a good feeling on the skin after use. This implies that the compositions are applied to the skin.

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply the compositions of EP '833 to the skin expecting a cleansing effect that leaves a good feeling on the skin after use.

Claim Rejections - 35 USC § 103

Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0 648 833 A1 (833) in combination with DE 43 04 066 A1 (066).

EP '833 teaches all the limitations of the claims as stated in the 35 U.S.C. 102(b)/103(a) rejections above. It does not teach lauryl ether sulfate. DE 066 discloses cleanser/surfactant compositions that contain N-acylamino acids and sodium lauryl ether sulfate. See example 1 at column 3. The expression "comprising" permits the presence of other ingredients and does not preclude the presence of other ingredients, active or inactive, even in major amounts. See *Moleculon Research Corporation v CBS, Inc.* 229 USPQ 805, *In re Baxter* 210 USPQ 795, 803.

It would have been obvious to one of ordinary skill in the art at the time of the invention to add sodium lauryl ether sulfate as taught by DE 066 to the compositions of EP '833 for its art-recognized surfactant properties.

Response to Arguments

Applicant's arguments with respect to claims 1-6 have been considered but are moot in view of the new ground(s) of rejection.

Art Unit: 1617

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Correspondence


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alysia Berman whose telephone number is 703-308-4638. The examiner can normally be reached Monday through Friday between 9:00 am and 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, can be reached on 703-305-1877. The fax phone

Art Unit: 1617

numbers for the organization where this application or proceeding is assigned are 703-872-9306 or 703-872-9307 for after-final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234 or 703-308-1235.


Alysia Berman
Patent Examiner
September 18, 2002


RUSSELL TRAVERS
PRIMARY EXAMINER
GROUP 1200